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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/328,216	10/25/94	DUNMIRE	C 1311914

EXAMINER
RIVELL, J

34M2/0222
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ART UNIT	PAPER NUMBER
3407	4

DATE MAILED: 02/22/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on 10/25/94 12/19/94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☑ Notice of Draftsman's Patent Drawing Review, PTO-948. (approved)
3. ☑ Notice of Art Cited by Applicant, PTO-1449. (2)
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 1-10 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-10 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 4, 6, 7, 9, 10 and 12, respectively, of U.S. Patent No. 5,226, 441. Although the conflicting claims are not identical, they are not patentably distinct from each other because the respective claims noted above of the patent contain all the elements of claims 1-9 of the application. Such broader instant application claims are said to "dominate" the more narrow patent claims which contain additional features. Thus, when U.S. Patent 5,226,441 expires one making the invention set forth in the respective claims of the expired patent would be infringing claims 1-9 of the instant application. This constitutes an unlawful extension of monopoly as set forth in the law. ***In re Braithwaite***, 154 USPQ 38,40.

Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,226,441 in view of Beukema. The device of claim 1 of the patent includes all the claimed features with the exception of having a sealing gasket to fluid tightly seal the conduit once cut and repositioned. The patent to Beukema discloses that it is known in the art of fluid couplings to employ a sealing gasket 37 in the coupling to fluid tightly seal the two piece coupling. It would have been obvious at the time the invention was made to a person having ordinary skill in

the art to employ in the device of claim 1 of the patent a sealing gasket for the purpose of fluid tightly sealing the two piece coupling as recognized by Beukema.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Applicant is reminded of the new format for terminal disclaimers (see M.P.E.P 1490, Rev. 14 November 1992) and 37 CFR §3.71 and §3.73 for procedures for assignees in submitting terminal disclaimers. Particular attention is directed to 37 CFR §3.73(b) wherein assignees must specify (e.g.reel and frame number) where evidence of ownership is recorded as well as a statement specifying that the evidence has been reviewed and certified.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rivell whose telephone number is (703) 308-2599.

JOHN RIVELL
PRIMARY EXAMINER
ART UNIT 347

j.r.
February 15, 1995